



Docket No.: 196466US-2



ATTORNEYS AT LAW

GREGORY J. MAIER
(703) 413-3000
GMAIER@OBLON.COM

SURINDER SACHAR
(703) 413-3000
SSACHAR@OBLON.COM

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 09/669,854

Applicants: Ikuyo IKEDA

2nd RCE MAY 24, 2005

Filed:

For: METHOD AND APPARATUS FOR EDITING AND
PROCESSING A DOCUMENT USING A PRINTER
DRIVER

Group Art Unit: 2176

Examiner: TRAN, Q.

SIR:

Attached hereto for filing are the following papers:

APPEAL BRIEF W/APPENDICES

Our credit card payment form in the amount of **\$500.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Surinder Sachar

Gregory J. Maier
Registration No. 25,599

Customer Number

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

Surinder Sachar
Registration No. 34,423



DOCKET NO: 196466US-2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

IKUYO IKEDA : EXAMINER: TRAN, Q.

SERIAL NO: 09/669,854 :

2ND RCE FILED: MAY 24, 2005 : GROUP ART UNIT: 2176

FOR: METHOD AND APPARATUS FOR
EDITING AND PROCESSING A
DOCUMENT USING A PRINTER DRIVER

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant appeals the outstanding Final Rejection of November 30, 2005.

(I) REAL PARTY IN INTEREST

The real party in interest in the present application is the assignee of the present application, Ricoh Company, Ltd., having a place of business at 3-6 Nakamagome 1-chome, Ohta-ku, Tokyo, Post No. 143-8555, Japan.

(II) RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representative, and the assignee are not aware of any other prior pending appeals, interferences, or judicial proceedings that may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

04/11/2006 SZEWDIE1 00000020 09669854

01 FC:1402

500.00 OP

(III) STATUS OF CLAIMS

Claims 15-24 are pending in this application and are being appealed.

Claims 1-14 were canceled during prosecution of the present application.

(IV) STATUS OF AMENDMENTS

No amendment was filed subsequent to the Final Rejection of November 30, 2005. A Request for Reconsideration was filed on January 24, 2006, which did not include any claim amendments.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The claims are directed to allowing a *printer driver* to perform an editing operation of inserting one of a text, an image, and a graphic into a displayed image. More specifically, the claims are directed to features of a *printer driver performing editing processes on image data* after a command to print a document has been issued. That is, in the claimed invention after a command to print a document has been executed and has been received by a printer driver, then in the claimed invention an editing process of inserting at least one of a text, an image, and a graphic into a displayed image can still be performed.

As discussed in the present specification with respect to the background, when an image to be printed is edited, a document can be processed in an application.¹ In the present apparatus and method an application is first activated to issue an order to print an original document, and then a printer driver is activated to start to operate.² Then, at least one of a text, an image, and a graphic is inserted into the original document while operating the printer driver. Then, various steps are taken by the printer driver to allow the printing of the document.

¹ Specification at page 1, lines 19-21.

² Specification at page 4, lines 1-4.

In the claimed invention an editing process on image data is performed on the printer driver instead of on applications.

With specific reference to the claim language, the claims are directed to a printing image forming apparatus, computer readable printer driver program, or printing image forming method in which a printer driver configured to be booted based on a received command prints a document from an application program. (Specification at page 4, lines 2-4).

According to the claimed invention a dialog device is configured to display an image on a screen based on and after receiving a command to print a document as a preview of printing. (See Figure 1A, Figure 2 step S12, and the specification at page 4, lines 3-6; the “means for displaying” including a display as shown in Figure 1A and the control operation of step S12).

An inserting device is configured to insert at least one of a text, an image, and a graphic into the displayed image, wherein the at least one of the text, image, and graphic are assigned on the display image on the screen by a user. (See the specification in Figure 1B showing an “Area Where a Note and Comment Is Inserted”, Figure 2, steps S13-S14, and the discussion in the present specification at page 4, lines 7-14; the “means for inserting” corresponding to those control operations S13-S14).

An image forming device forms an image by inserting the at least one of the text, image, and graphic in the position specified by the user on the displayed image on the screen. (See Figure 1B in the present specification and Figure 2, step S15, and the discussion in the present specification at page 4, lines 14-16; the “means for forming an image” corresponding to the control operation step S15 in Figure 2 in the present specification).

A display indicating device displays the formed image on the screen. (See Figure 1B in the present specification and step S16 in Figure 2 and the discussion in the present

specification at page 4, lines 16-18; the “means for displaying” corresponding to the display in Figure 1B and the control operation in step S16).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 15-24 are pending in this application. Claims 15, 18, 21, and 24 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 6,661,530 to Munetomo et al. (herein “Munetomo”) in view of U.S. patent 6,069,637 to Gaglione et al. (herein “Gaglione”). Claims 16, 19, 20, and 22 were rejected under 35 U.S.C. § 103(a) as unpatentable over Munetomo in view of Gaglione. Claims 17 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Munetomo in view of Gaglione and further in view of U.S. patent 6,462,756 to Hansen et al. (herein “Hansen”).

(VII) ARGUMENT

Applicant traverses the above-noted rejections.

As noted above, the claims are directed to allowing a *printer driver* to perform an editing operation of inserting one of a text, an image, and a graphic into a displayed image. Such features are reflected in the claims and are neither taught nor suggested by any of the cited art, in any combination.

More specifically, the claims are directed to features of a *printer driver performing editing processes on image data* after a command to print a document has been issued. That is, in the claimed invention after a command to print a document has been executed and has been received by a printer driver, then in the present invention an editing process of inserting at least one of a text, an image, and a graphic into a displayed image can still be performed. Such features are believed to clearly differ from the applied art.

As discussed in the present specification with respect to the background, when an image to be printed is edited, a document can be processed in an application.³ In the present apparatus and method an application is first activated to issue an order to print an original document, and then a printer driver is activated to start to operate.⁴ Then, at least one of a text, an image, and a graphic is inserted into the original document while operating the printer driver. Then, various steps are taken by the printer driver to allow the printing of the document. Such features of the performing the noted operations in a printer driver of a printing image forming apparatus are believed to clearly distinguish over the applied art.

In the present invention an editing process on image data is performed on the printer driver instead of on applications, unlike the prior art.

Initially, applicant wishes to address a statement made in the Advisory Action of February 15, 2006 as support for the outstanding rejection which is believed to be clearly erroneous. Applicant presented arguments that the claims do not disclose or suggest the features of a *printer driver* performing an editing operation. In response to the Advisory Action states:

...it is noted that the features upon which applicant relies (i.e., printer driver performing editing an image data) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (see claims 15-24 pages 2-5).

Thus, using the broadest reasonable interpretation of the claims, since Claims 15-24 do not explicitly claim such feature (printer driver performing editing on image data), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to read the claims limitation in the broadest interpretation as cited above.

Therefore claims 15-24 are deemed to be proper at least for above the reason at this time.⁵

³ Specification at page 1, lines 19-21.

⁴ Specification at page 4, lines 1-4.

⁵ Advisory Action of February 15, 2006, last three paragraphs.

Applicant submits the above-noted statement is simply erroneous and based on the erroneous statement above the outstanding rejections must be *reversed*.

Independent claim 15 recites as the first positive element of the claimed printing image forming apparatus a “printer driver”. Claim 15 goes on to recite “the *printer driver comprising*...an inserting device configured to insert at least one of a text, an image, and a graphic into the displayed image” (emphasis added). Thus, independent claim 15 clearly recites the printer driver itself including a device to perform an editing by inserting at least one of a text, an image, and a graphic into a displayed image. The other independent claims recite similar limitations.

The statement noted above that such features are not reflected in the claims is thereby believed to be completely erroneous and for that reason alone the outstanding rejection must be *reversed*.

In even further detail, applicant respectfully submits the basis for the outstanding rejection is simply not properly considering the claimed features relative to the claimed invention, and in fact even mischaracterizes applicant’s presented arguments to the allowability of the claims. Specifically, the basis for maintaining the outstanding rejection states:

Additionally, the main thrust of the applicant’s arguments is Munetomo, Gaglione and Hansen are not properly combined and do not teach, **insert at least one of the text, an image, and a graphic into a display image.**⁶

Applicant respectfully submits the above-noted basis for maintaining the outstanding rejection misconstrues applicant’s presented arguments, which are also presented below. Specifically, applicant at no point argued that Munetomo, Gaglione or Hansen do not teach inserting at least one of a text, an image, and a graphic into a display image. In fact, applicant concedes that editing features are disclosed in the art. However, the claims do not

⁶ Final Office Action of November 30, 2005, page 9, first full paragraph (original emphasis).

merely recite inserting at least one of a text, an image, and a graphic in a display, but instead the claims specifically recite that a *printer driver* includes an inserting device to insert at least one of a text, an image, and a graphic, and which takes place after receiving a command to print a document. It was conventional to have a regular application, such as a word processing application, insert at least one of a text, an image, and a graphic into a display image. What is *not conventional*, and what is recited in the claims, is that a *printer driver* performs such an insertion after receiving a command to print a document.

As discussed in further detail below, Munetomo clearly discloses a computer including an application 1-12 and a printer driver 1-15. Applicant respectfully submits any editing of an insertion of at least one of a text, and an image, and a graphic is performed by that application 1-12, and is *not performed by the printer driver 1-15*. Further, applicant respectfully submits that Gaglione does not disclose or suggest any teaching that would result in one of ordinary skill in the art modifying the printer driver 1-15 in Munetomo to be able to insert at least one of a text, an image, and a graphic, after receiving a command to print a document.

One basis for maintaining the outstanding rejection also appears to indicate that the Examiner is using “the broadest reasonable interpretation of the claims”.⁷ Applicant believes that is not the case. The claims clearly positively recite the *printer driver* performing the insertion of at least one of a text, an image, and a graphic after receiving a command to print a document. No reasonable interpretation of the claims could ignore such positively recited features.

The basis for the outstanding rejection has not properly considered the claimed features of the printer driver performing the noted insertion of at least one of a text, an image, and a graphic, as discussed in even further detail below.

⁷ Final Office Action of November 30, 2005, page 9, second paragraph.

Addressing now the primary reference to Munetomo in further detail, Munetomo appears to disclose a conventional system of a printer in Figure 1 showing an application 1-12 and a printer driver 1-15 as part of a memory 1-11 of a computer 1-1. However, applicant respectfully submits Munetomo does not disclose or suggest any operation in which the printer driver 1-15 can insert at least one of a text, an image, and a graphic into a displayed image.

Munetomo appears to disclose a conventional printer driver that does not have any editing operations such as noted above. Munetomo specifically states “[t]he printer driver 1-15 which is specific to each model of printers, reconfigures the printing data sent from the operating system 1-14 into a form that the printer 1-4 can directly recognize, and sends the reconfigured data to the printer interface 1-6”.⁸ From this disclosure Munetomo discloses the printer driver 1-15 as a conventional printer driver that cannot perform any editing operations.

With respect to the feature of being able to insert an image into a displayed image, the outstanding rejection cites Munetomo at col. 3, line 64 through col. 4, line 11.⁹ That basis for the outstanding rejection is improper. That basis for the outstanding rejection appears to reference an 11th embodiment in Munetomo and an operation of a double-sided printing mode, but does not disclose any operation of inserting an image into a displayed image. Details of such an 11th embodiment are also noted in Munetomo at col. 20, line 4 et seq. At that portion, Munetomo does not disclose any operation in which a printer driver can insert an image into a displayed image.

Therefore, Munetomo does not disclose or suggest the printer driver taking any sort of editing operation of being able to insert any material into a displayed image. In such ways, Munetomo does not disclose the above-noted features recited in the claims.

⁸ Munetomo at col. 8, lines 26-30.

⁹ Final Office Action of November 30, 2005, page 3, lines 4-14.

Moreover, as apparently recognized in the Office Action, Munetomo does not disclose specifics of inserting at least one of a text, an image, and a graphic into a displayed image via a printer driver.

To overcome that recognized deficiency in Munetomo the outstanding rejection cites Gaglione at col. 7, line 29 through col. 8, line 35, and also Figure 7. However, applicant notes such teachings in Gaglione first are not related to the teachings in Munetomo and are not related to the claimed features.

At the noted portion in Gaglione, Gaglione discloses an editing operation in which a text mode can be entered into, to provide text for an image. However, such teachings in Gaglione are *not performed by a printer driver*. Such teachings in Gaglione would appear to be performed by a device such as the application 1-12 in Munetomo. Thereby, if such teachings in Gaglione were combined with the teachings in Munetomo, that would allow the application 1-12 in Munetomo to be able to enter a text entering mode to allow text to be entered.

However, the claims are not directed to such a feature.

The claims are directed to a *printer driver* being able to insert at least one of a text, an image, and a graphic into a displayed image. Neither Munetomo nor Gaglione teach or suggest such a feature, and no combination of teachings of Munetomo or Gaglione would suggest such a feature.

As noted above, Munetomo discloses an application 1-12 that would appear to perform editing operations, and a printer driver 1-15 that formats data for printing. Munetomo does not disclose or suggest the printer driver 1-15 being able to perform any editing of inserting at least one of a text, an image, and a graphic to a displayed image.

Moreover, Gaglione also does not teach or suggest the printer driver being able to perform an editing to insert at least one of a text, an image, and a graphic into the displayed

image. Thus, combining the teachings of Gaglione and Munetomo would not result in the above-noted claimed feature. As noted above, any combination of teachings in Gaglione and Munetomo would at most result in the application 1-12 in Munetomo being able to enter a text entering mode. That is not what the claims recite, as noted above.

One other basis for maintaining the rejection appears to be that the disclosure in Gaglione is directed to Eastman Kodak printers, which are “usually embedded with the printer driver to perform all the features that [are] described above”.¹⁰

That basis for the outstanding rejection is improper. There does not appear to be any teaching or suggestion in Gaglione itself that would suggest a printer driver can perform the claimed editing functions. In Figure 1, in fact, Gaglione appear to disclose just the opposite.

More particularly, in Figure 1 Gaglione discloses a central processing unit 10 that can take the form of any appropriate computer.¹¹ Gaglione goes on to note that an output device 34 may be a printer PCD 600.¹² Thus, it is actually clear in Gaglione that *all the editing being performed is being performed by the CPU 10 and not by any element within the printer 34.*

The outstanding rejection has not at all pointed out on the record where Gaglione discloses that the output device 34, noted as a printer, includes editing functions. Applicant believes that is the case because Gaglione does not disclose the features relied upon in the Office Action, i.e., the Office Action clearly misconstrues the teachings in Gaglione.

Further, the noted teachings in Gaglione at column 7, line 29 to column 8, line 35 are directed to a text editing portion 120, which again appears to be a screen provided on the CPU 10, and not in the printer 34. That disclosure again clearly indicates that Gaglione does not disclose or suggest a printer driver being able to insert at least one of a text, an image, and a graphic into a display image after receiving a command to print a document.

¹⁰ Final Office Action of November 30, 2005, page 10, lines 11-12.

¹¹ Gaglione at column 4, lines 6-8.

¹² Gaglione at column 4, lines 53-58.

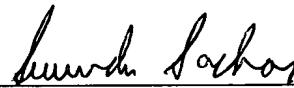
In such ways, clearly the teachings in Gaglione do not overcome the above-noted deficiencies in Munetomo, in contrast to the basis for the outstanding rejection.

Moreover, no teachings in Hansen are cited with respect to the above-noted features, nor any teachings in Hansen believed to overcome the above-discussed deficiencies of Gaglione and Munetomo.

For the foregoing reasons, applicant respectfully submits the outstanding rejections are clearly improper and must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599

Surinder Sachar
Registration No. 34,423

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
SNS/rac

I:\ATTY\SNS\19's\196466\196466US-AB.DOC



(VIII) CLAIM APPENDIX

Claims 1-14 (Canceled).

Claim 15 (Previously Presented): A printing image forming apparatus, comprising:
a printer driver configured to be booted based on a received command to print a
document from an application program, the printer driver comprising:

a dialog device configured to display an image on a screen based on and after
receiving the command to print a document as a preview of printing;

an inserting device configured to insert at least one of a text, an image, and a
graphic into the displayed image, wherein the at least one of the text, image, and
graphic are assigned on the displayed image on the screen by a user;

an image forming device configured to form an image by inserting the at least
one of the text, image and graphic in a position specified by the user on the displayed
image on the screen; and

a display indicating device configured to display the formed image on the
screen.

Claim 16 (Previously Presented): A printing image forming apparatus according to
claim 15, wherein:

the inserting device reduces the image to be printed and moves the reduced image in
up-and-down and right-and-left directions on the screen so as to form a space for inserting the
at least one of the text, image, and graphic.

Claim 17 (Previously Presented): A printing image forming apparatus according to
claim 15, wherein:

the displayed formed image includes a combined image of an original document and the inserted at least one of the text, image, and graphic, and the combined image is edited by a drag and drop operation on the preview of printing.

Claim 18 (Previously Presented): A recording medium recorded with a computer readable printer driver program performing the steps of:

receiving a command to print a document;
displaying an original document on a screen as a preview of printing based on and after receiving the command to print a document;
receiving at least one of a text, an image, and a graphic to be inserted into an image of the displayed original document from a user;
receiving a position specified by the user on the displayed image on the screen so as to form a space for inserting the at least one of the text, image, and graphic;
inserting the at least one of the text, image, and graphic into the formed space; and displaying a combined image on the screen.

Claim 19 (Previously Presented): A print controlling apparatus, comprising:
a computer in which the printer driver program according to claim 18 is installed.

Claim 20 (Previously Presented): An image processing system, comprising:
a print controlling apparatus according to claim 19; and
a printer.

Claim 21 (Previously Presented): A printing image forming apparatus, comprising:

a printer driver configured to be booted based on a received command to print a document from an application program, the printer driver comprising:

means for displaying an image on a screen based on and after receiving the command to print a document as a preview of printing;

means for inserting at least one of a text, an image, and a graphic into the displayed image, wherein the at least one of the text, image, and graphic are assigned on the displayed image on the screen by a user;

means for forming an image by inserting the at least one of the text, image, and graphic in a position specified by the user on the displayed image on the screen;
and

means for displaying the formed image on the screen.

Claim 22 (Previously Presented): A printing image forming apparatus according to claim 21, wherein:

the means for inserting reduces the image to be printed and moves the reduced image in up-and-down and right-and-left directions on the screen so as to form a space for inserting the at least one of the text, image, and graphic.

Claim 23 (Previously Presented): A printing image forming apparatus according to claim 21, wherein:

the displayed formed image includes a combined image of an original document and the inserted at least one of the text, image, and graphic, and the combined image is edited by a drag and drop operation on the preview of printing.

Claim 24 (Previously Presented): A method for forming a printing image performing the steps of:

receiving a command to print a document;

displaying an original document on a screen as a preview of printing based on and after receiving the command to print a document;

receiving at least one of a text, an image, and a graphic to be inserted into an image of the displayed original document from a user;

receiving a position specified by the user on the displayed image on the screen so as to form a space for inserting the at least one of the text, image, and graphic;

inserting the at least one of the text, image, and graphic into the formed space; and displaying a combined image on the screen.

(IX) EVIDENCE APPENDIX

None

(X) RELATED PROCEEDINGS APPENDIX

None